

CP - 2761
orney Docket No.: WD2-98-120

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE NOV 01 1999

Group 2700

Application of: Jay S. Walker et al.)
)
For: SETTLEMENT SYSTEMS AND) Examiner: Not assigned
METHODS WHEREIN A BUYER)
TAKES POSSESSION AT A)
RETAILER OF A PRODUCT)
PURCHASED USING A)
COMMUNICATION NETWORK)
)
Serial No.: 09/348,566) Group Art Unit: 2761
)
Filing Date: July 7, 1999) Docket No.: WD2-98-120

Assistant Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL LETTER

Applicants hereby submit the following documents for the above-identified patent application:

1. Information Disclosure Statement;
2. PTO form-1449;
3. References cited herein (44), and
4. Postcard.

The Assistant Commissioner is hereby authorized to charge the associated filing fee in the amount of \$0.00 to Deposit Account No. 50-0271. Order No. WD2-98-120. A duplicate copy of this sheet is attached. The Assistant Commissioner is hereby authorized to charge any additional fees which may be required for the submission of this paper, or credit any overpayment, to Deposit Account No. 50-0271. Order No. WD2-98-120. A duplicate copy of this sheet is attached.

Respectfully submitted,

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October 27, 1999
Date

Certificate of Mailing

I hereby certify that this correspondence is being sent via first-class mail in an envelope with sufficient postage addressed to Assistant Commissioner for Patents, Washington, D.C. 20231 on October 27, 1999.

Veronika S. Leliever
Typed Name of Person Making Deposit

Signature

10/27/99
Date



Docket No. WD2-98-120

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In re Application of: Jay S. Walker et al.)
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For: SETTLEMENT SYSTEMS AND) Examiner: Not Yet Assigned
METHODS WHEREIN A)
BUYER TAKES POSSESSION)
AT A RETAILER OF A)
PRODUCT PURCHASED)
USING A COMMUNICATION)
NETWORK)
)
Serial No.: 09/348,566) Group Art Unit: 2761
)
Filing Date: July 7, 1999) Docket No.: WD2-98-120

Assistant Commissioner for Patents
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Sir:

Applicants submit herewith patents, publications or other information of which they are aware that they believe may be material to the examination of this application, and in respect of which, there may be a duty to disclose.

The filing of this information disclosure statement shall not be construed as a representation that a thorough search has been made, an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists. Nor shall the filing of this information disclosure statement be construed as an admission against interest in any manner.

This Information Disclosure Statement is filed in accordance with 37 C.F.R. §§1.56, 1.97 and 1.98. The items listed below and on the accompanying Form PTO-1449 may be deemed to be pertinent to the above-identified application and are made of record to assist the Patent and Trademark Office in its examination of this application. The Examiner is respectfully requested to fully consider these items and to independently ascertain their teaching.

- A. U. S. Patent No. 4,341,951 entitled "ELECTRONIC FUNDS TRANSFER AND VOUCHER ISSUE SYSTEM", issued to William M. Benton on July 27, 1982.
- B. U. S. Patent No. 4,734,858 entitled "DATA TERMINAL AND SYSTEM FOR PLACING ORDERS", issued to Hubert J. Schlafly on March 29, 1988.
- C. U.S. Patent No. 4,799,156 entitled "INTERACTIVE MARKET MANAGEMENT SYSTEM" issued to Shavit et al. on January 17, 1989.
- D. U.S. Patent No. 4,882,675 entitled "PAPERLESS SYSTEM FOR DISTRIBUTING, REDEEMING AND CLEARING MERCHANDISE COUPONS", issued to Nichtberger et al. on November 21, 1989.
- E. U.S. Patent No. 5,010,485 entitled "APPARATUS, SYSTEM AND METHOD FOR CREATING CREDIT VOUCHERS USABLE AT POINT OF PURCHASE STATIONS", issued to Steven T. Bigari on April 23, 1991.
- F. U.S. Patent No. 5,191,410 "INTERACTIVE MULTIMEDIA PRESENTATION AND COMMUNICATIONS SYSTEM", issued to McCalley et al. on March 2, 1993.
- G. U.S. Patent No. 5,256,863 "IN-STORE UNIVERSAL CONTROL SYSTEM", issued to Ferguson et al. on October 26, 1993.
- H. U.S. Patent No. 5,305,195 "INTERACTIVE ADVERTISING SYSTEM FOR ON-LINE TERMINALS", issued to Arthur J. Murphy on April 19, 1994.
- I. U.S. Patent No. 5,319,542 entitled "SYSTEM FOR ORDERING ITEMS USING AN ELECTRONIC CATALOGUE" issued to King, Jr. et al. on June 7, 1994.

- J. U.S. Patent No. 5,434,394 entitled "AUTOMATED ORDER AND DELIVERY SYSTEM" issued to Roach et al. on July 18, 1995.
- K. U.S. Patent No. 5,495,412 entitled "COMPUTER-BASED METHOD AND APPARATUS FOR INTERACTIVE COMPUTER-ASSISTED NEGOTIATIONS" issued to Ernest M. Thiessen on February 27, 1996.
- L. PCT Publication No. WO 97/21200 entitled "HIDDEN DATA TRANSPORT ELECTRONIC COUPON SYSTEM" published to Chong Lee et al. on June 12, 1997.
- M. PCT Publication No. WO 97/23838 entitled "SYSTEM AND METHOD FOR PROVIDING SHOPPING AIDS AND INCENTIVES TO CUSTOMERS THROUGH A COMPUTER NETWORK" published to Scroggie et al. on July 3, 1997.
- N. PCT Publication No. WO 97/35441 entitled "INCENTIVE BASED INFORMATION GENERATION SYSTEM" published to M.W. Walden on September 25, 1997.
- O. PCT Publication No. WO 98/06050 entitled "SYSTEM AND METHOD FOR A TARGETED PAYMENT SYSTEM DISCOUNT PROGRAM" published to R. L. Peirce et al. on February 12, 1998.
- P. Abstract of PCT Publication No. WO 98/15907 entitled "METHOD AND DEVICE FOR CONSTRUCTING A DATABASE CONTAINING CUSTOMER DATA AND/OR FOR ORGANIZING A DISCOUNT OR COUPON SYSTEM" published to Martin Finsterwald on April 16, 1998.
- Q. Quinn, Jane Bryant, "New Cars for Less", Newsweek, October 23, 1978; Section: The Columnists, at pg. 80.

- R. Hilts, Paul, "Technology meets commerce; electronic publishing; includes articles on the World Wide Web and the annual Military Book Show; ABA '96", Publishers Weekly, Section: Vol. 243; No. 28; Pg. 43; ISSN: 0000-0019; July 8, 1996.
- S. U.S. Patent No. 5,515,268 entitled "METHOD OF AND SYSTEM FOR ORDERING PRODUCTS", issued to Kiyoshi Yoda on May 7, 1996.
- T. U.S. Patent No. 5,537,314 entitled "REFERRAL RECOGNITION SYSTEM FOR AN INCENTIVE AWARD PROGRAM" issued to Mark W. Kanter on July 16, 1996.
- U. U.S. Patent No. 5,557,721 entitled "METHOD AND APPARATUS FOR DISPLAY SCREENS AND COUPONS", issued to Kenneth R. Fite on September 17, 1996.
- V. U.S. Patent No. 5,590,197 entitled "ELECTRONIC PAYMENT SYSTEM AND METHOD", issued to Chen et al. on December 31, 1996.
- W. U.S. Patent No. 5,592,375 entitled "COMPUTER-ASSISTED SYSTEM FOR INTERACTIVELY BROKERING GOODS OR SERVICES BETWEEN BUYERS AND SELLERS", issued to Salmon et al. on January 7, 1997.
- X. U.S. Patent No. 5,612,527 entitled "DISCOUNT OFFER REDEMPTION SYSTEM AND METHOD" issued to Victor A. Ovadia on March 18, 1997.
- Y. U.S. Patent No. 5,708,782 entitled "METHOD AND APPARATUS FOR DISPENSING DISCOUNT COUPONS" issued to Larson et al. on January 13, 1998.

- Z. U.S. Patent No. 5,710,886 entitled "ELECTRIC COUPONING METHOD AND APPARATUS" issued to Christensen et al. on January 20, 1998.
- AA. U.S. Patent No. 5,710,887 entitled "COMPUTER SYSTEM AND METHOD FOR ELECTRONIC COMMERCE" issued to Chelliah et al. on January 20, 1998.
- BB. U.S. Patent No. 5,754,653 entitled "CODING FORMULA FOR VERIFYING CHECKS AND CREDIT CARDS" issued to Henry A. Canfield on May 19, 1998.
- CC. U.S. Patent No. 5,758,328 entitled "COMPUTERIZED QUOTATION SYSTEM AND METHOD" issued to Joseph Giovannoli on May 26, 1998.
- DD. PCT Publication No. WO 98/21713 entitled "MERCHANDIZING SYSTEM" published to Leville et al. on May 22, 1998.
- EE. "About CyberSlice",
(<http://www.cyberslice.com/cgi-bin/WebObjects/CyberSlice:2@httpserv01/>),
download date: May 6, 1997.
- FF. "My Auto Broker - Online Auto Broker",
(<http://www.adverlink.com/myautobroker/>), download date: May 28, 1997.
- GG. U.S. Patent No. 5,761,648 entitled "INTERACTIVE MARKETING NETWORK AND PROCESS USING ELECTRONIC CERTIFICATES" issued to Golden et al. on June 2, 1998.
- HH. U.S. Patent No. 5,774,870 entitled "FULLY INTEGRATED, ON-LINE INTERACTIVE FREQUENCY AND AWARD REDEMPTION RPOGRAM" issued to Thomas W. Storey on June 30, 1998.

- II. U.S. Patent No. 5,806,044 entitled "SYSTEM AND METHOD FOR DISTRIBUTING COUPONS THROUGH A SYSTEM OF COMPUTER NETWORKS" issued to Ken R. Powell on September 8, 1998.
- JJ. U.S. Patent No. 5,832,457 entitled "METHOD AND APPARATUS FOR SELECTIVE DISTRIBUTION OF DISCOUNT COUPONS BASED ON PRIOR CUSTOMER BEHAVIOR" issued to O'Brien et al. on November 3, 1998.
- KK. U.S. Patent No. 5,845,259 entitled "ELECTRONIC COUPON DISPENSING SYSTEM" issued to West et al. on December 1, 1998.
- LL. U.S. Patent No. 5,848,399 entitled "COMPUTER SYSTEM FOR ALLOWING A CONSUMER TO PURCHASE PACKAGED GOODS AT HOME", issued to Raymond R. Burke on December 8, 1998.
- MM. U.S. Patent No. 5,855,007 entitled "ELECTRONIC COUPON COMMUNICATION SYSTEM" issued to Jovicic et al. on December 29, 1998.
- NN. U.S. Patent No. 5,857,175 entitled "SYSTEM AND METHOD FOR OFFERING TARGETED DISCOUNTS TO CUSTOMERS" issued to Day et al. on January 5, 1999.
- OO. U.S. Patent No. 5,864,604 entitled "METHOD OF PROVIDING MESSAGE SERVICE FOR LIMITED ACCESS TELECOMMUNICATIONS" issued to Moen et al. on January 26, 1999.
- PP. U.S. Patent No. 5,870,716 entitled "HOME TERMINAL AND SHOPPING SYSTEM" issued to Sugiyama et al. on February 9, 1999.
- QQ. "PriceWatch",
(<http://icon.co.za/-robo/prod01.htm>), download date: June 9, 1997.

RR. "Reaching out in new directions - introducing U\$A Value Exchange", First Data Corp. Merchant Services, Brochure.

1. ☐ Any copy of the items listed above and on the enclosed copy of Form PTO-1449 that is not enclosed with this Information Disclosure Statement was previously cited by or submitted to the Patent and Trademark Office in the prior ☐ Continuation, ☐ Divisional or ☐ Continuation in part application filed under 37 C.F.R. §§ 1.53 or 1.60, U.S. Serial No. _____, filed _____.
2. ☐ For each of the following items listed above and on the enclosed copy of Form PTO-1449 that is not in the English language, a European Search Report from a counterpart European application is enclosed. Such items are marked as reference letter(s): _____.
3. ☐ For each of the following items listed above and on the enclosed copy of Form PTO-1449 that is not in the English language, a concise explanation of the relevance of that item is incorporated in the specification of the above-identified application. Such items are marked as reference letter(s): _____.
4. ☒ In addition to the citations listed above, applicants respectfully direct the Examiner's attention to the following U.S. patent applications, which are commonly assigned to the assignee of the instant application, and which may be deemed pertinent to the instant application:

<u>Serial No.</u>	<u>Inventors</u>	<u>Filing Date</u>	<u>Group Art Unit</u>	<u>Examiner's Init.</u>
08/858,738	Walker et al.	05/19/97	2764	
08/943,483	Walker et al.	10/03/97	2765	
08/997,677	Walker et al.	12/23/97	3662	
08/997,680	Walker et al.	12/23/97	2876	
09/263,617	Walker et al.	03/05/99	2764	
09/285,201	Walker et al.	04/01/99	2771	
09/316,546	Walker et al.	05/21/99	2761	

The Examiner is respectfully requested to fully consider and independently ascertain the teachings and relevance of those applications with respect to the instant application.

5. ☒ No fee is believed to be due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with:
- ☐ 37 C.F.R. §1.97(b)(1), within three months of the filing date of the above-identified application.
- ☐ 37 C.F.R. §1.97(b)(2), within three months of the date of entry into the national stage as set forth in §1.491.
- ☒ 37 C.F.R. §1.97(b)(3), before the mailing date of a first Office Action on the merits.

6. ☐ No fee is believed to be due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. 1.97(c), after the period specified in paragraph 5 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action), and is accompanied by one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 10 below.
7. ☐ A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c) after the period specified in paragraph 5 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action). The fee due under 37 C.F.R. §1.17(p) is to be paid as set forth in paragraph 11 below.
8. ☐ A fee is due under 37 C.F.R. §1.17(i)(1) for this Information Disclosure Statement since it is being filed in accordance with 37 C.F.R. §1.97(d), after the mailing date of a final action or a Notice of Allowance, but before the payment of the issue fee, and is accompanied by:
- a. one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 10 below; and
 - b. this document is to be considered as a petition requesting consideration of the information disclosure statement.
 - c. the fee due under 37 C.F.R. §1.17(i)(1) which is paid as set forth in paragraph 11 below.
9. ☐ A fee is due under 37 C.F.R. §1.17(i)(1) for this Information Disclosure Statement since it is being filed in compliance with:
- ☐ 37 C.F.R. §1.313(b)(3), after the issue fee has been paid and information cited in this Information Disclosure Statement may render at least one claim unpatentable and is accompanied by the attached Petition to Withdraw Application from Issue;
 - ☐ 37 C.F.R. §1.313(b)(5), after the issue fee has been paid and information cited in this Information Disclosure Statement is to be considered in a Continuation application upon abandonment of the instant application and is accompanied by the attached Petition to Withdraw Application from Issue.
 - ☐ The fee due under 37 C.F.R. §1.17(i)(1) is paid as set forth in paragraph 11 below.

10. ☐ I hereby certify:

- ☐ that each item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. A copy of such communication is enclosed.
- ☐ that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the undersigned after making reasonable inquiry, was known to any individual designated in §1.56(c) more than three months prior to the filing of this Information Disclosure Statement.

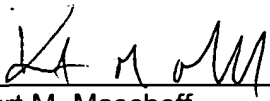
11. ☐ Please accept payment of the fees due as indicated below:

- ☐ A check in the amount of \$240.00 is enclosed in payment of the fee due under 37 C.F.R. 1.17(p).
- ☐ The Commissioner is hereby authorized to charge \$240.00 to Deposit Account No. 50-0271 in payment of the fee due under 37 C.F.R. §1.17(p). A duplicate copy of this sheet is attached for such purpose
- ☐ A check in the amount of \$130.00 is enclosed in payment of the fee due under 37 C.F.R. §1.17(i)(1).
- ☐ The Commissioner is authorized to charge \$130.00 to Deposit Account No. 50-0271 in payment of the fee due under 37 C.F.R. §1.17(i)(1). A duplicate copy of this sheet is attached.

12. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any overpayment to Deposit Account No. 50-0271. A copy of this authorization is attached.

October 27, 1999
Date

Respectfully submitted,



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